

### **REMARKS**

Claims 11 and 18 are being amended to recite a process comprising coating a darkly lacquered surface. This amendment introduces no new matter and is supported throughout the specification as filed, *inter alia*, on page 1, lines 29-30.

#### **Rejections under 35 U.S.C. § 103 (a)**

Claims 11-16, 18 and 20 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Shvartsman (EP 0 439 050 A2) in view of Yin et al., U.S. Patent No. 4,978,593, further in view of Lewis et al., U.S. Patent No. 4,519,065. This rejection is respectfully traversed.

The present invention is directed to processes for forming a decorative design on darkly lacquered surfaces. The processes are particularly useful for decorating body parts of a car, by creating decorative effects that are visible to the human eye, with the apparent colors visible being dependent in part on viewing angle. The present invention is not directed to recording media or data storage.

Shvartsman discloses a method for making an optical image element having a high aspect ratio relief hologram. The hologram is apparently intended as an "information-carrying layer" (page 3, lines 26-27). The method includes applying a photohardenable film to the surface of an optically transparent substrate; embossing the surface using a stamper containing a reverse image of the hologram; passing actinic radiation through the transparent substrate and the photohardenable film to harden the film; and separating the stamper from the embossed photohardened film. The Examiner states that "Shvartsman does not specifically teach the pattern of the die". Applicant respectfully submits that the pattern of the die is irrelevant. The present claims are directed to a novel process for decorative design of a darkly lacquered surface and not to a particular pattern. In contrast to the present claims, Shvartsman states that the substrate to which the hologram is applied should be "substantially transparent" to radiation that is to be applied thereto during end use (page 3, lines 27-29). Applicant submits that a darkly lacquered part is not expected to be optically transparent.

Yin also discloses a method for making holograms on transparent surfaces. The stated use for the invention is on automotive windows. The present claims are directed to designs for darkly lacquered surfaces and processes for

making the designs. Applicant submits that “darkly lacquered surfaces” are clearly not automotive windows. Nowhere does Yin suggest that the disclosed method would be applicable to darkly lacquered substrates such as automotive body parts.

Applicant further submits that one skilled in the art would recognize that the method disclosed by Shvartsman is intended for making an optical element for use in, for example, an optical scanner (e.g., page 9, Example 1 of Shvartsman). Accordingly, Applicant submits that a person of ordinary skill in the art related to automotive coatings would not be led to Shvartsman. Thus, Applicant submits, there would have been no motivation for a person of ordinary skill in the art to combine the teachings of Yin with those of Shvartsman.

Lewis discloses information storage devices having grooves or modulations in a conductive or reflective metal layer, useful in forming video discs. Applicant respectfully submits that Applicant fails to understand the Examiner’s reasoning in applying the disclosures of Lewis in combination with those of Svartsman, because, the Examiner states that “Lewis teaches that radiation for curing may occur through the transparent die” and that it would have been obvious “to radiate through the transparent substrate taught by Svartsman”, and thus, the Examiner apparently concludes, the combination of the references suggests that “the holograms may be applied to non-transparent substrates as well”. Applicant respectfully disagrees. Applicant further respectfully submits that the combined disclosures of Lewis and Svartsman do not result in the steps recited in the present claims. Accordingly, Applicant respectfully submits that claims 11-16, 18 and 20 are not obvious over Svartsman in view of Yin and/or Lewis.

Claims 11-16, 18 and 20 were also rejected under 35 U.S.C. § 103 as being unpatentable over Gili Picoy, U.S. Patent No. 5,318,807 (“Gili”) in view of Yin.

Gili discloses a process for preparing printed sheets with optical effects. The process is intended for implementation on “paper or paperboard or any other absorbent material”. The material is printed, then a “lacquer, thermoplastic resin or other material” is applied, impregnating the surface. The surface is then engraved, using a calendar, with ultrafine interferences or cylindrical lenses. Applicant respectfully submits that the process and application thereof disclosed by Gili is different from the presently claimed process, in that the presently claimed process does not include printing on an absorbent material. Yin has been discussed

hereinabove, and as noted, is directed to automotive windows. Thus, even if the disclosures of Gili were combined with those of Yin, the resulting combination does not disclose or suggest the present claims. Accordingly, Applicant respectfully submits that Gili in combination with Yin does not disclose, teach, or suggest the present claims.

### **CONCLUSION**

In view of the present amendments and the above Remarks, Applicant respectfully submits that all of claims 11-16, 18 and 20 are patentable over the cited references. Accordingly, withdrawal of all rejections under 35 U.S.C. § 103(a) and issuance of a Notice of Allowance are respectfully requested.

Should there be a fee due which is not accounted for, please charge such fee to Deposit Account No. 04-1928 (E.I. du Pont de Nemours and Company).

Respectfully submitted,

Date: January 10, 2005

By: Gail Dalickas  
Gail Dalickas  
Attorney for Applicants  
Reg. No.: 40,979  
Phone: (302) 984-6282  
Fax: (302) 658-1192